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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,415	08/03/2001	Hirotaka Inagaki	401181	7811

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EXAMINER
COBURN, CORBETT B

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SM.

Office Action Summary	Application No.	Applicant(s)	
	09/830,415	INAGAKI ET AL.	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-17 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 27 April 2001 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Pachinko Machine With Story Display In Which The Story Provides Indication Of The State Of The Game.

2. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the specification appears to be a literal translation from a foreign language and is replete with grammatical and idiomatic errors.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

3. The specification should be a succinct description of the claimed invention. A mere recitation of the claims in the specification such as that contained in Applicant's "Disclosure of the Invention" adds nothing to the disclosure. When submitting the substitute specification, Applicant should carefully review this section to see if it adds anything of value to the specification. If, as it appears, any of this section merely reiterates the claims, this language should be deleted. Naturally, any language that actually explains the claims should be retained.

Drawings

4. The drawings are objected to because of the issues noted on the attached Notice of Draftsperson's Patent Drawing Review. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. Examiner also notes that there are many drawings that do not illustrate any features contained in the claims. Any drawing that is necessary to illustrate the claimed invention should be retained, but Examiner urges Applicant to consider deleting those that either do not apply to the claimed invention or only do so tangentially. Applicant might also consider removing or editing material that is of a provocative or sexually suggestive nature. It has, for instance, been suggested to the Examiner that the bare breasts and panties depicted in Fig 12 are really germane to the Applicant's invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Claim 3 is particularly full of grammatical and typographical errors. It is unclear what the limitation "the scenario progresses according to

timing in stopping of the variation display" means. Examiner assumes that this means that the scenario stops when the reels stop.

8. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This limitation "if the variation display stops an additional, second special symbol at a second specific arrangement", appears to be missing some text. Examiner believes this to mean that there are two special game states represented by two different sets of reel combinations. Or, to use the language of the Applicant's disclosure, there is a "reach" state and a "big hit" state, each represented by different symbol combinations.

9. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 contains the limitation, "wherein the suggestion display is shown when the game is not being played and, if being played, when the variation display of the special symbol is not shown." Examiner believes this limitation to mean that the suggestion display is only shown when the reels are not spinning.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1-17 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's disclosure.

Claim 1: On page 2, Applicant teaches a game machine with a means for displaying a special symbol indicating a shift to a special game state if a variation display stops at a specific arrangement and for displaying a game-related production display is known to the art. (Lines 1-8) Applicant discloses that the prior art also teaches means for determining results of stopping of the variation display and controlling the means for displaying according to the results. The means for determining controls the means for displaying to produce a production display of a scenario of a game-related production display from a beginning to an end of the scenario during a period from a start to an end of the variation display. (See the discussion of the golf game display, lines 9-21.)

Claim 2: On lines 18-21 of page 2, Applicant describes a prior art game in which the end of the scenario indicates whether to shift to the special game state. The golf ball hits the hole if the game shifts to the special game state.

Claims 3 & 4: On page 4, lines 10-16, Applicant admits that in the prior art, the scenario does not come to an end unless the special symbol is shown when the reels stop. This means that if the special symbol is on the stopped reels, the means for determining

controls the means for displaying so that the scenario progresses according to timing in stopping of the variation display – i.e., the scenario stops when the reels stop. If the special symbol does not appear when the reels stop, the means for determining controls the means for displaying so that the scenario progresses irrespective of timing of stopping of the variation display – i.e., the scenario does not stop when the reels stop.

Claim 5: On page 3 of the Applicant's specification, Applicant discloses that in the prior art, it is known to have the means for determining change the production display to show an evolution of the scenario when a state of the game indicates a shift to the special game state if the variation display stops an additional, second special symbol at a second specific arrangement – i.e., the type of fish caught depends on the reel combination.

Claims 7 & 8: From Applicant's description on page 9, it appears that "production design" includes characters. Thus, "progress of the scenario shown with the production display changes with a production design", means that progress of the scenario is shown when certain characters appear. Applicant admits that it is known to the art to show progress in the scenario by the appearance of certain types of fish. (Specification, page 3) These fish are characters and are, therefore, "production designs".

Claims 10 & 11: Applicant's specification discloses that it is known in the art to have a gaming machine with means for displaying designs related to a game (page 2, 1-9) and means for controlling a display on the means for displaying, wherein the means for controlling produces a production display of a process from a beginning to an end of a scenario (e.g., the golf game discussed on page 2), and controls the means for displaying to display an indication, with a specific arrangement, that the game has moved to a

special game state at the end of the scenario – e.g., the golf ball falls into the hole to indicate that the game has moved to a special game state.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosure as applied to claim 5 above, and further in view of Barrie (GB 2,144,644).

Claim 6: Applicant's specification reveals that the prior art teaches the invention substantially as claimed. For instance, Applicant describes a fishing scenario in which the evolution of the scenario is indicated by changes in the fish caught. Changing the background to indicate the evolution of the scenario is merely a cosmetic design choice. However, Barrie teaches changing the background to indicate the evolution of the scenario. (Figs 5-8) This adds to the visual appeal of the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have indicated the evolution of the scenario by changes in a background of the production display in order to add visual appeal to the game.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosure as applied to claim 1 in view of Claypole et al. (GB 2,262,642).

Claim 9: Applicant's disclosure reveals that the prior art teaches the invention substantially as claimed. While Applicants disclosure does not specifically teach that the

means for displaying includes a display zone for the production display larger than a display zone for the variation display of the special symbol, this is purely a matter of aesthetic design choice. Claypole teaches an analogous device in which the display zone for the production display is larger than the reels. (Fig 1) Having the means for displaying include a display zone for the production display larger than a display zone for the variation display of the special symbol would make it easier for the player to view the production display. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the means for displaying include a display zone for the production display larger than a display zone for the variation display of the special symbol in order to make it easier for the player to view the production display.

15. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosure in view of Fuchs (US Patent Number 5,630,753).

Claims 12, 13 & 17: On page 4, lines 25-30, Applicant describes prior art in which the means for displaying game-related designs including a special symbol indicating a shift to a special game state if a variation display stops at a specific arrangement, and including a production design indicating a probability of shifting to the special game state– Applicant discloses a production display containing the message, "Big-hit probability is high." This indicates which production design has a high probability of shifting to the special game state. Applicant does not teach that the means for controlling controls the means for displaying to produce a suggestion display of relationship between the production design and the probability of shifting to the special game state. Such "suggestion displays" are commonly called pay tables and are well known to the art.

Fuchs teaches such a "suggestion display" (7). Suggestion displays (or pay tables) give players information they need to understand the symbols being presented on the screen. This greatly increases player understanding and enjoyment of the game. It would have been obvious to one of ordinary skill in the art to have the means for controlling control the means for displaying to produce a suggestion display of relationship between the production design and the probability of shifting to the special game state in order to give players information they need to understand the symbols being presented on the screen, thus greatly increases player understanding and enjoyment of the game.

Claim 14: Fuchs teaches that the suggestion display (7) shows a design related to the production design – in this case the diamonds in the suggestion display (7) are related to the diamonds in the game. This makes it easier for the player to understand the suggestion display.

Claim 15: While Fuchs does not specifically teach that the suggestion display includes an animated image, animated images are extremely well known to the art and are used to add visual interest to a game, thus increasing the number of people playing the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the suggestion display include an animated image in order to add visual interest to a game, thus increasing the number of people playing the game.

Claim 16: Neither Applicant's disclosure nor Fuchs specifically teaches the suggestion display (pay table or help information) being shown when the game is not being played and, if being played, when the variation display of the special symbol is not shown (i.e., when the reels are not spinning). However, the spinning reels, the production design (the

moving pictures or scenario) and the suggestion display share the same physical display device. Whenever the reels are spinning, the production design must be playing. Having the suggestion display displayed when the reels are spinning and the production design is playing would clutter up the screen, making it difficult for the player to understand the game. This would defeat the purpose of displaying the suggestion display. It would have been obvious to one of ordinary skill in the art to have the suggestion display is shown when the game is not being played and, if being played, when the variation display of the special symbol is not shown in order to reduce screen clutter and make it easier for the player to understand the game.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reference Name	US Patent Number	Applicability
Walker et al.	6,234,896	Video with slot machine
Kodachi et al.	6,142,874	Pachinko machine with event indicator
Giobbi et a.	6,155,925	Reel game with scenario showing win
Jaffe et al.	6,358,147	Reel game with scenario

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

cbc
November 21, 2002

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